

REMARKS

I. Status of the Claims

Claims 1-41 are pending in this application. Claims 1, 35, 37, 38, 40, and 41 have been amended. Support for these amendments can be found, for example, on page 6 of the specification as-filed. No new matter has been introduced by these amendments nor do these amendments necessitate any additional search by the Office. Applicants respectfully submit that the above-detailed amendments place this application in condition for allowance.

II. Rejection Under 35 U.S.C. § 103

The rejection of claims 1-41 under 35 U.S.C. § 103(a) as unpatentable over Japanese Application No. JP 11 - 021227 to *Takeshi* ("*Takeshi*") and U.S. Patent No. 5,567,420 to *McEleney et al.* ("*McEleney*") has been maintained in the Advisory Action dated February 10, 2003. Applicants respectfully disagree with and traverse this rejection for at least the reasons previously provided on the record and for the additional reasons set forth below.

To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing, *inter alia*, that all of the elements of the claimed invention are taught or suggested by the cited references. M.P.E.P. § 2143. As is explained below, the cited reference combination fails to satisfy at least this requirement.

Takeshi and *McEleney*, even though improperly combined, singly and in combination, fail to teach all of the elements of Applicants' claims. As Applicants explained in the October 9, 2002 Interview, which Applicants thank the Examiner and

her Supervisor for conducting, the references fail to teach Applicants' at least one ingredient chosen from pigments and fillers comprising "at least one water-repellent and oil-repellent agent on the surface of the at least one ingredient." To determine patentability, the Examiner must consider each and every element of Applicants' claims, including that highlighted above. M.P.E.P. § 2106(II)(C).

In the Advisory Action, the Examiner seems to suggest that specific, quantitative effective amounts must be recited in the claims. (Advisory Action dated February 10, 2003, page 2.) Applicants disagree. The Examiner has not pointed to any disclosure in either reference that teaches or suggests that pigments and/or fillers, regardless of amount, have or can have on their surface at least one water-repellant and oil-repellant agent. Because each and every element of Applicants' claims is not taught or suggested by the cited references, Applicants are not required to amend the claims.

Unlike the cited references, Applicants' specification describes in detail that the at least one ingredient is surface-treated by at least one water-repellant and oil-repellant agent. For example, the specification provides that "the surface treatment of the pigment and/or filler can be performed by any method, such as by physical adsorption of compounds onto the pigment and/or filler surface, by chemical bonding with functional groups on the pigment and/or filler surface, and by physical methods such as mechanofusion." (Specification, page 6, lines 10-13 (emphasis supplied).) Thus, the claims and specification make clear that the at least one water-repellant and oil-repellant agent is on the surface of the at least one ingredient. Neither cited reference, nor their combination, teaches this element of Applicants' claims, let alone surface treatment of pigments and/or fillers for any purpose. Thus, contrary to the Examiner's

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

suggestion, Applicants need not amend the claims further to include a specific, quantitative limitation.

Accordingly, because no *prima facie* case of obviousness has been established by the cited reference combination, Applicants request withdrawal of this rejection.

III. Conclusion

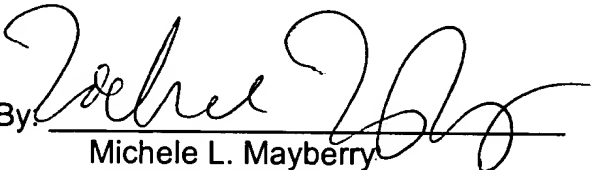
In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 17, 2003

By: 
Michele L. Mayberry
Reg. No. 45,644

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com